



Doc Code AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional) G07.042

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on May 15, 2006

Signature

Typed or printed name Edith Martin

Application Number

09/682,787

Filed: October 18, 2001

First Named Inventor: Kenneth Beirne

Art Unit 3624

Examiner: Thu Thao Havan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☒ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 45,371

Randolph P. Calhoun
Signature

Randolph P. Calhoun
Typed or printed name

(203) 972-5985
Telephone number

May 15, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: BEIRNE et al.

Application Serial No.: 09/682,787

Filing Date: October 18, 2001

For: METHOD, SYSTEM, AND
STORAGE MEDIUM FOR PRE-
SCREENING CUSTOMERS FOR
CREDIT CARD APPROVAL AT A
POINT OF SALE

) Group Art Unit: 3624

) Examiner: Thu Thao Havan

) **REASON(S) FOR REQUESTING A PRE-
APPEAL BRIEF REVIEW**

) Attorney Docket No.: G07.042

) **PTO Customer Number 28062**
) Buckley, Maschoff & Talwalkar LLC
) Five Elm Street
) New Canaan, CT 06840

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 15, 2006.

By: 

Edith Martin

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated March 14, 2006, Applicant respectfully requests a Pre-Appeal Brief Review for the reason(s) that begin on page 2 of this paper.

REASON(S) FOR REQUESTING A PRE-APPEAL BRIEF REVIEW

Claims 1-37 are in the application. Claims 1, 17, and 33 are the independent claims herein.

Claims 1-37 stand finally rejected under 35 USC 103(a) as being unpatentable over Lent et al., U.S. 6,324,524 (hereinafter, Lent) in view of Walker et al., U.S. 6,336,104 (hereinafter, Walker). Applicant respectfully submits that the cited and relied upon Lent and Walker fail, as a matter of fact, to disclose or suggest at least one aspect recited in all of the pending claims. Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the final rejection.

Applicant's independent claims 1, 17, and 33 variously relate to a method, storage medium, and a system for pre-screening customer data of a customer by a selling entity at a point of sale location. See Applicant's Response to September 21, 2005 Final Office Action, page 9, paragraphs 4 and 5.

In particular, the claims recite: receiving said customer data at a point of sale system; and during the course of a single check out process at said point of sale location: performing a credit worthiness check to determine a credit pre-approval of said customer, said performing is done using a result of said searching and without knowledge of and uninitiated by said customer.

Applicant references the Response to September 21, 2005 regarding the deficiencies of Lent(See page 10, paragraph 2 – page 12, paragraph 1)

Applicant notes that the Non-Final Office Action dated September 21, 2005 cited and relied upon Lent for disclosing all of the claimed aspects except for an explicit disclosure of a point of sale system. For the disclosure of a point of sale system, the Office Action relied upon Walker. That is, the September 21, 2005 Office Action cited and relied upon Lent for all of the recited aspects of claims 1, 17, and 33 except of the point of sale system.

However, the Final Office Action dated March 14, 2006 relies upon Walker for “performing a credit worthiness check to determine a credit pre-approval of [a] customer, [where the] performing is done using a result of searching and without knowledge of and uninitiated by [the] customer”, citing Walker, col. 4, ln. 50-67; col. 5, ln. 1-65; col. 6, ln. 42-54; col. 2, ln. 9-21; col. 7, ln. 1-15; and col. 14, ln. 14-32. Applicant respectfully notes that the Office’s new arguments for the final rejection of the claims were not necessitated by any amendment of the claims by Applicant. The Office Action clearly, and for the first time, cites and relies on Walker for disclosing the claimed performing a credit worthiness check without knowledge and uninitiated by the customer. As a matter of fact, Applicant made no claim amendments in the Response to the Non-Final Office Action dated September 21, 2005 (filed December 21, 2005 by Applicant).

Regarding the alleged disclosure of Walker relied upon by the Office, Applicant respectfully submits that Walker, as a matter of fact, does not disclose or suggest that for which it is cited and relied upon for disclosing. Walker fails to disclose or suggest (at least) performing a credit worthiness check to determine a credit pre-approval of the customer, the performing is done using a result of the searching and without knowledge of and uninitiated by the customer.

Walker in fact discloses authorizing the purchase price according to the terms of an installment plan. A “step 362 is also known as ‘authorizing the charge’, and typically comprises an evaluation of whether the credit card account meets approval criteria of the credit card issuer”, Walker, col. 9, ln. 66 – col. 10, ln. 2. (See Response to January 28, 2005 Final Office Action, page 11, paragraph 1) The charge authorization is part of a purchase initiated by a customer. The charge authorization is for a purchase amount, either a total amount or an installment amount according to an installment plan. In either case, the charged purchase price is initiated by the customer making the purchases and choosing to pay using pre-existing credit card. (See Walker, col. 8, ln. 33- col. 9, ln. 37) The option of paying by the pre-existing credit card is selected (i.e.,

initiated) by the customer and the installment plan is selected (i.e., initiated) by the customer.

Furthermore, the charge authorization explicitly disclosed by Walker is a conventional charge authorization that is conducted in association with a conventional credit card or credit account authorization. It is well-known by customers having a credit card or charge account that the purchase price is authorized or approved before the sale is finalized.

Thus, the Walker customer, as a matter of fact, initiates the charge authorization by selecting to pay in installments billed to a credit account and is further aware of the authorization process since a charge authorization is a well-known aspect of charging purchases to a pre-existing credit card.

Accordingly, Applicant respectfully submits that, as a matter of fact, neither of the cited and relied upon Walker and Lent disclose or suggest (at least) the claimed performing a credit worthiness check to determine a credit pre-approval of the customer, the performing is done using a result of the searching and without knowledge of and uninitiated by the customer.

Also, a clear error in the Final Office Action's rejection includes the Examiner's statement that Walker discloses a point of sale wherein the customer is unaware of a pre-approval credit card until an offer is mailed or the customer is contacted via email. (See Final Office Action, page 3, paragraph 1) However, Applicant does not claim that a customer is aware or unaware of a card but instead claims the performing of a credit worthiness check to determine a credit pre-approval of the customer, the performing is done using a result of the searching and without knowledge of and uninitiated by the customer. Thus, it is the performing of the credit worthiness check, not the existence of the card.

Therefore, Applicant respectfully submits that the cited and relied upon Lent and Walker fail to disclose or suggest performing a credit worthiness check to determine

a credit pre-approval of the customer without knowledge of and uninitiated by the customer, as claimed by Applicant.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the cited and relied upon combination of Lent and Walker does not render claims 1, 17, and 33 obvious under 35 USC 103(a). The reconsideration and withdrawal of the rejection of claims 1, 17, and 33 are requested.

Applicant respectfully submits that dependent claims 2-16, 18-32, and 34-37 are patentable for at least depending on a patentable base claim.

Respectfully submitted,

May 15, 2006
Date

A handwritten signature in black ink, appearing to read "Randolph P. Calhoun", written over a horizontal line.

Randolph P. Calhoun
Registration No. 45,371
Buckley, Maschoff & Talwalkar LLC
Five Elm Street
New Canaan, CT 06840
(203) 972-5985